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10/585,594

07/10/2006

Hirokazu Taniguchi

52433/852

4328

26646 7590 10/15/2009  
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EXAMINER

YANG, JIE

ART UNIT

PAPER NUMBER

1793

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/585,594             | TANIGUCHI ET AL.    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | JIE YANG               | 1793                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/13/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Claim 1 has been amended, claims 2-7 are cancelled, and claim 1 is pending in application.

### ***Status of the Previous Rejection***

The previous rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Takada et al (EP 1 160 346 A1, thereafter EP'346) is withdrawn since claim 6 has been cancelled according to the Applicant's amendment and remarks filed on 6/9/2009.

The previous rejections of claim 6 under the ground of nonstatutory obviousness type double patenting are withdrawn since claim 6 has been cancelled according to the Applicant's amendment and remarks filed on 6/9/2009.

The previous rejections of claim 1 under second paragraph of 35 U.S.C. 112 is withdrawn in view of the amendment filed on 6/9/2009.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, the Applicant change the open-end phrase "containing" to the close-end phrase "consisting of" in the instant claim 1 without literal support because at least Ni is listed as an additional element for the alloy as recited in the instant invention (Paragraph [0014], [0023], table 1 and 5, and original claim 6 of the original specification). Therefore, the close-end phrase "consisting of" is recognized as a new matter for the instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al (EP 1 160 346 A1, thereafter EP'346).

EP'346 is applied to claim 1 for the same reason as stated in the previous office actions marked 2/5/2009.

Regarding the term "consisting of" in the instant claim, which excluding the additional elements, such as Ni from the claimed alloy, EP'346 teaches adding 0.2-5.0%Ni in the alloy, which overlapping the original disclosed 1%Ni or less as recited

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in the original application ((Paragraph [0014], [0023], table 1 and 5, and original claim 6 of the original specification). At the same time, EP'346 teaches Cu, Ni, and Mn have the same function of austenite-stabilizing (paragraph [0019] of EP'346). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the Ni with function equivalent Cu and/or Mn in EP'346 with expected success. MPEP 2144.06.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masaaki et al (JP 2003105491 A1, thereafter JP'491).

Regarding claim 1, JP'491 teaches a high strength galvanized steel plate excellent in formability (title, abstract of JP'491). The composition comparison between the alloy of JP'491 (Abstract and claim 1 of JP'491) and the instant application is listed in the following table. All the composition ranges disclosed by JP'491 overlap the composition ranges of the instant claims, which is a prima facie case of obviousness. SEE MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the compositions of C, Si, Mn, P, S, Al, Mo, N, Fe and further adding Cu and Cr as claimed in the instant claim

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from the composition disclosed by JP'491, because JP'491 discloses the same utility throughout the disclosed ranges.

| Element | From instant Claim 1<br>(in wt%) | JP'491(in wt%)<br>(ref. Abstract, Cl.1-12) | Overlapping range<br>(in wt%) |
|---------|----------------------------------|--|-------------------------------|
| C       | 0.08-0.35                        | 0.08-0.3                                   | 0.08-0.3                      |
| Si      | 1.0 or less                      | Less than 0.2                              | Less than 0.2                 |
| Mn      | 0.8-3.5                          | 0.8-2.8                                    | 0.8-2.8                       |
| P       | 0.03 or less                     | 0.03 or less                               | 0.03 or less                  |
| S       | 0.03 or less                     | 0.03 or less                               | 0.03 or less                  |
| Al      | 0.25-1.8                         | 0.25-1.8                                   | 0.25-1.8                      |
| Mo      | 0.05-0.35                        | 0.05-0.3                                   | 0.05-0.3                      |
| N       | 0.010 or less                    | 0.010 or less                              | 0.01 or less                  |
|         | optional                         |  |                               |
| Ti      | 0.01-0.03                        |  |                               |
| Nb      | 0.01-0.03                        |  |                               |
| V       | 0.01-0.03                        |  |                               |
| Cu      | 1 or less                        | 1.0 or less                                | 1.0 or less                   |
| Cr      | 1 or less                        | 1.0 or less                                | 1.0 or less                   |
| B       | 0.0001-0.0030                    |  |                               |
| Fe      | Balance                          | Balance                                    | Balance                       |

JP'491 teaches the similar basic elements as recited in the instant claim, which meets the limitation of "consisting of" as recited in the instant claim. JP'491 teaches about 5% retained austenite and the structure also includes ferrite, bainite (Abstract of JP'491), and JP'491 further teaches the conditions for the martensite generation (paragraph [0042] of JP'491), which overlaps the 5vol.% or more residual austenite and reads on the ferrite, bainite and martensite structure as recited in the instant claim. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

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to control the working and annealing conditions as demonstrated by JP'491 in order to obtain adesired microstructures.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-7 of copending application No. 10/560989 in view of EP'346.

Claims 1-7 of copending application No. 10/560989 in view of EP'346 is applied to the instant claim 1 for the same reason as stated in the previous office actions marked 2/5/2009.

Regarding the amended features in the instant claim 1, claim 1 of copending application No. 10/560989 teaches the similar basic elements and overlapping the composition ranges with the basic elements as recited in the instant claim, which reads on the "consisting of" limitation in the instant claim. Claim 2 of copending application No. 10/560989 teaches the similar additional elements as recited in the instant claim.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-10 of copending application No. 10/558579 in view of EP'346.

Claims 1-10 of copending application No. 10/558579 in view of EP'346 is applied to the instant claim 1 for the same reason as stated in the previous office actions marked 2/5/2009.

Regarding the amended features in the instant claim 1, claim 1 of copending application No. 10/558579 teaches the similar basic elements and overlapping the composition ranges with the basic elements as recited in the instant claim, which reads on the "consisting of" limitation in the instant claim. Claim 2 of copending application No. 10/558579 teaches the similar additional elements as recited in the instant claim.



Claim 1 is provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-3 of copending application No. 10/591919 in view of EP'346.

Claims 1-13 of copending application No. 10/591919 in view of EP'346 is applied to the instant claim 1 for the same reason as stated in the previous office actions marked 2/5/2009.

Regarding the amended features in the instant claim 1, claim 1 of copending application No. 10/591919 teaches the similar basic elements and overlapping the composition ranges with the basic elements as recited in the instant claim, which reads on the "consisting of" limitation in the instant claim. Claim 2 of copending application No. 10/591919 teaches the similar additional elements as recited in the instant claim.

### ***Response to Arguments***

Applicant's arguments filed on 6/9/2009 with respect to claim 1 have been fully considered but they are not persuasive. Regarding the Applicant's arguments related to the amended feature in the instant claims, the Examiner's position is stated as above.

The Applicant argues that the instant claimed alloy adding Mo and excluding Ni, which contrasts to the alloy of EP'346. In response, the Examiner notes the Ni and Mo ranges taught by EP'346 overlap the original disclosed Ni and Mo ranges. The Examiner further notes, EP'346 teaches Cu, Ni, and Mn have the same function of

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austenite-stabilizing (paragraph [0019] of EP'346). MPEP 2144.06. Detail discussions can refer to the rejection for the instant claim as above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/  
Supervisory Patent Examiner, Art Unit 1793